

REMARKS

The application has been amended and is believed to be in condition for allowance. The present amendment is submitted as part of a Request for Continued Examination ("RCE").

Claims 1-9, 11-16 and 20-21 remain in this application.

Amendments to the Disclosure

Claim 1 is amended to overcome the Official Action's rejection under 35 USC 112, second paragraph as indicated below.

Claim 1 is further amended to clarify the recitations of the distinguishing features of the invention. The amendments to claim 1 find support in the specification and the drawing figures as originally filed (e.g., page 4, lines 2-3 and lines 11-14) and do not introduce new matter.

Claim 16 is amended to depend from claim 21.

Claim 21 is amended to structurally recite the card of claim 1 in combination with the holder.

The claims are further amended to address some antecedent basis issues and some formal matters in consideration of U.S. practice and preferences.

New claims 22-24 are introduced to further distinguish the invention over the prior art. The new claims find support in the specification and the drawing figures as originally filed (e.g., page 4, lines 11-29) and do not introduce new matter.

Claims 17-19 are canceled without prejudice.

Rejections under Section 112, Second Paragraph

The Official Action rejected claim 1 under 35 USC 112, second paragraph, stating that the recitations of "damage" and "erasure of data" renders the claim indefinite as simultaneously claiming a broad and a comparably narrower scope.

The Official Action further rejected claim 1 under 35 USC 112, second paragraph stating that the use of the phrase "and/or" renders the claim indefinite, and suggests the use of the phrase "at least one of ... and..." in each instance of "and/or" in the claim.

In reply, claim 1 has been amended in a manner responsive to the Official Action's suggestion. In particular, claim 1 has been amended expressly toward protecting a card having an electronic data-carrying element from inadvertent erasure of data, and the use of "and/or" has been amended as suggested by the Official Action.

Accordingly, withdrawal of the rejection under 35 USC 112, second paragraph is respectfully solicited.

Rejections under Sections 102 and 103

The Official Action rejected claim 1 under 35 USC 102(b) as being anticipated by Miller (US 5,524,750; "MILLER").

The Official Action rejected claims 6-9 and 11 under 35 USC 103(a) as being unpatentable over MILLER.

The Official Action rejected claims 4-5, 18-19, and 21 under 35 USC 103(a) as being unpatentable over MILLER in view of Wen Chi Hu (FR 2,638,619; "HU").

The Official Action rejected claims 2, 12, 16, and 20 under 35 USC 103(a) as being unpatentable over MILLER in view of Littman (US 3,027,995; "LITTMAN").

The Official Action rejected claim 14 under 35 USC 103(a) as being unpatentable over MILLER and LITTMAN, and further in view of HU.

The Official Action rejected claims 3 and 17 under 35 USC 103(a) as being unpatentable over MILLER and LITTMAN, and further in view of Parker (US 4,792,058; "PARKER").

The Official Action rejected claim 15 under 35 USC 103(a) as being unpatentable over MILLER, LITTMAN, PARKER, and HU.

The rejections are respectfully traversed for at least the reasons that follow.

It is firstly noted that claim 1 has been amended expressly toward protecting a card having an electronic data-carrying element from inadvertent erasure of data, as indicated above as to the rejection under 35 USC 112, second paragraph, and further amended to clarify the structural characteristics related to this feature.

It is thus respectfully submitted that none of the cited references, individually or in combination, teach or

suggest a holder comprised of shielding metal sheets formed of a soft ferromagnetic material having a high magnetic permeability and wherein the shielding metal sheets configured to envelop the data-carrying element of the card and protect the data-carrying element from any of magnetic and electromagnetic radiation external to the holder.

The Official Action states that it has been held within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, citing *In re Lashin*, 125 USPQ 416, 277 F.2d 197.

Here, however, there is no evidence provided by any of the cited references, individually or in combination, that the suitability of the materials selected by the Applicant for the application recited in the claim, protecting a data-carrying element from any of magnetic and electromagnetic radiation external to the holder, was in any way known in the art prior to the date of invention.

As described in the specification of the present application, "[t]he choice of sheet material is very important. It must have high magnetic permeability in order to protect the card and a high saturation level so as not to lose its protective ability against powerful magnetic fields. It must also be a so-called soft ferromagnetic material so that it does not become a permanent magnet," (page 4, lines 11-14).

Unlike the plastic material of *In re Lashin*, the choice of material in the present application is directed to a purpose and a function not contemplated by any of the cited references. That is, none of the cited references teach protection from external magnetic and/or electromagnetic radiation, and none suggest a particular composition of metal having any properties or effects toward such protection.

For example, MILLER fails to teach this feature. On the contrary, MILLER expressly discloses that a use of "a metal material" is at best interchangeable with plastic, and at worst is less preferred over plastic (column 2, lines 5-11). Plastic has no properties for protecting a data-carrying element from external magnetic and/or electromagnetic radiation, and MILLER makes no further teaching as to a use of metal to suggest choosing a particular metal composition suitable for this purpose, as recited in claim 1.

HU, also fails to teach this feature. HU makes no teaching as to any material as to any purpose, much less metal and certainly not toward protecting from external magnetic and/or electromagnetic radiation. At best, HU teaches only protection against a physical damage (i.e., a scratch) to a magnetic strip of a card (Abstract).

LITTMANN fails to teach this feature. LITTMANN's disclosure of metal is limited to spring steel (column 1, lines 11-14), and requires no properties of said metal outside being

"ornamental" (column 2, lines 4-6) and being resilient such to self-close and retain a closed position (column 1, lines 15-17 and lines 55-56).

PARKER makes no teaching or suggestion of any metallic material.

Hence, the recitation of a soft ferromagnetic material having a high magnetic permeability and configured to envelop the data-carrying element of the card and protect the data-carrying element from any of magnetic and electromagnetic radiation external to the holder, as recited in claim 1, yields a result wholly unexpected by the cited references. At least, none of the cited references presents any evidence that the use of soft ferromagnetic material having a high magnetic permeability was within the level of ordinary skill at the time the claimed invention was made.

It is therefore respectfully submitted that none of the cited references, individually or in combination, teach or suggest a holder comprised of shielding metal sheets formed of a soft ferromagnetic material having a high magnetic permeability and configured to envelop the data-carrying element of the card and protect the data-carrying element as recited by amended claim 1.

In addition, it is respectfully submitted that there is nothing in MILLER teaching or suggesting that the a size of a first sheet portion closely corresponds to a size of the card

such that an area of the first sheet portion completely overlaps the whole surface area of the card.

On the contrary, MILLER illustrates sheet portions 22 and 24 wider clearly outsizing the card 15. Nothing in any of MILLER's figures or specification suggests the structure recited in amended claim 1.

It is therefore respectfully submitted that claim 1, as amended, is patentable over the references cited by the Official Action, and that claim 1 is thereby patentable.

It is further respectfully submitted that claims depending from claim 1, including new claims 22-24, are patentable at least for depending from a patentable claim.

For example, as to claims 6-7, and 16, the Official Action states that "rigid electrical sheet metal was a known metal material and it is generally within the knowledge of one having ordinary skill in the art at the time the invention was made to include any type of metal that was available, including transformer sheet."

The Official Action further alleges that Applicant admits that transformer sheet metal was a known material at the time of the invention and was commercially available from Nippon Steel.

Applicant respectfully disagrees. It is respectfully submitted that Applicant makes no admittance that the properties of either Electrical Steel, or in particular, transformer sheet

metal, were known to be suitable to protect the data-carrying element of a any of a bank card, key card, membership card, cash card, and payment card from external magnetic and/or electromagnetic radiation.

Applicant's specification, as originally filed, discloses...

After extensive tests during is (sic) which many types of steel were tested, the applicant found that the material class Electrical Steel has magnetic properties that meet the requirements for the protection of credit cards of LoCo quality. In particular, transformer sheet metal has been found to be suitable for use as holder material.

(Page 4, lines 11-18; emphasis added)

Hence, Applicant makes no disclosure that the magnetic properties of the materials as recited toward the present invention were in any way known in the art.

On the contrary, the specification discloses that that the desired properties of the recited materials were established by the Applicant's diligent experimentation, and therefore cannot disclose any evidence that the suitability and desirability of the recited materials were known in the art at the time the invention was made. (See also "Electrical Steel" as a particular class of materials having specific magnetic properties; e.g., http://en.wikipedia.org/wiki/Electrical_steel).

As the Official Action concedes that MILLER fails to expressly disclose a metal shielding sheet made either of electrical steel of transformer sheet, it is respectfully submitted that the references cited by the Official Action

fail to teach the features required by dependent claims 6-7, and 17-19.

Accordingly, it is respectfully submitted that claims 6-7, and 16 are patentable in their own right over the cited references in addition to being dependent from a patentable parent claim.

As to claims 8, 9, 11, and 20, it is further respectfully submitted that none of the cited references, individually or in combination, teach or suggest a shielding metal having a thickness as claimed.

The Official Action concedes that none of the cited references teach or suggest the recitations of claims 8, 9, 11, and 20, but contends that where the only difference between the prior art and the claims is a recitation of relative dimensions, and the claimed relative dimensions would not perform differently than a prior art device, the claimed device is not patentably distinct from the prior art device.

Applicant respectfully disagrees. As indicated above, none of the cited references teach protection from external magnetic and/or electromagnetic radiation, and none suggest a particular composition of metal having any properties or effects toward such protection.

It is therefore respectfully submitted that none of the cited references, individually or in combination, teach or

suggest that the claimed dimensions would perform similarly or identically to the devices recited in the prior art.

On the contrary, one of skill would readily understand that thickness affects magnetic properties. Further, the present application describes a prototype of 0.27 mm thick 27ZDKH95 transformer sheet from Nippon Steel providing satisfactory protection during tests with a typical magnet in women's handbags with a field of a maximum of 70 mT, (page 4, lines 24-27). "When a credit card or bank card was placed in a holder of transformer sheet, the information on the card was not erased by the effect of such a field," (page 4, lines 27-29).

There is no teaching or suggestion in any of the cited references either of magnetic properties of a protective sheet or a relationship between a thickness of the sheet and a protection provided by said sheet. Hence, none of the cited references provide any teaching or suggestion with respect to magnetic protective properties, and certainly provide no evidence teaching or suggesting prior art that performs similarly or identically to the invention claimed.

It is therefore respectfully submitted that claims 8, 9, 11, and 20 are patentable in their own right over the cited references in addition to being dependent from a patentable parent claim.

Reconsideration and allowance of the claims are respectfully requested.

From the foregoing, it will be apparent that Applicant has fully responded to the April 27, 2009 Official Action and that the claims as presented are patentable. In view of this, Applicant respectfully requests reconsideration of the claims, as presented, and their early passage to issue.

In order to expedite the prosecution of this case, it is requested that the Examiner telephone the attorney for Applicant at the number set forth below if the Examiner is of the opinion that further discussion of this case would be helpful.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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